



D-1112 R4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Enright, et al.)	
)	
Application No.: 09/991,748)	Art Unit 3692
)	
Confirmation No.: 7030)	
)	
Filed: November 23, 2001)	Patent Examiner
)	Frantzy Poinvil
)	
Title: Automated Banking Machine)	
System and Method)	

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejections in the above-identified application (as presented in the Office Action dated October 19, 2006).

No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reason that the rejections are not legally valid because the applied reference does not anticipate the claims.

Claim Status

Claims 1-39 are pending, with claims 1, 17, 26, 36, and 37 being independent.

Claims 1-39 were rejected as anticipated pursuant to 35 U.S.C. § 102(e) over Stinson (US 6,149,056).

Argument

Appellants respectfully disagree with the features attributed to the Stinson reference by the Office. Stinson does not explicitly or inherently anticipate the claims for at least these reasons:

- 1). Stinson does not teach, mention, or need "electronic signature" (e.g., independent claims 1, 17, 26, 36, and 37). Thus, Stinson cannot anticipate the claims.
- 2). Stinson does not teach an electronic signature that comprises an image of a machine user.
- 3). The Office (e.g., at Action page 3, last paragraph) admits that in Stinson a customer is required to endorse (sign) a check by writing their signature on the check. Stinson teaches that the customer is to sign the check *before* it is even inserted into the machine (e.g., col. 7, lines 46-58). One having ordinary skill in the art would recognize that Stinson's requirement of a hand-written signature teaches away from Stinson using (or needing) an electronic signature. Nor has the Office explained what purpose an electronic signature would serve in Stinson when a hand-written signature is what is relied upon by Stinson (as admitted by the Office).

4). Stinson does not receive an agreement input (regarding electronic signature) from a user of the machine. The Action (on page 3, last paragraph) alleges that "the machine or ATM system of Stinson et al asked the user" to agree that an "imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document" and "it is then inherent that the user has/had agreed".

First, the Action is silent as to where the allegation that a machine "asked the user" for authorization can be found in Stinson. Nor does Stinson teach the alleged asking feature.

Second, as previously mentioned, if Stinson uses a customer's hand-written signature (as admitted by the Office), then why would Stinson need a user's electronic signature "for purposes of signing the document", as alleged by the Office (at Action page 4, line 1)? Stinson doesn't. Stinson's use of a hand-written signature teaches away from any need of an electronic signature.

Third, even if Stinson somehow taught (which Stinson doesn't) the Office's allegation that "the user has/had agreed to" authorization, the agreement would not have been received via an input *from a user of the machine*. Even the Action's past tense usage of "has/had agreed" indicates any customer agreement (if somehow possible) in Stinson would have occurred before the customer used the machine.

Fourth, the Office's allegation that "it is then *inherent* that the user has/had agreed" is without any supporting basis. To establish inherency the Office must prove that the feature alleged to be inherent is mandatory or "necessarily present" in Stinson. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The Office has not proved the alleged inherency. Nor is structure that absolutely requires the carrying out of the recited methods mandatory or "necessarily present" in Stinson. Nor is there any prior art evidence of record that Stinson's device, in its normal and usual operation, would be required to perform the recited methods.

5). Stinson (including relied upon col. 8, lines 11-44) does not teach claims 2-8, 20, and 31-34, as alleged by the Office (at Action page 5). Where does Stinson teach applying indicia to a check inserted in his machine? Where does Stinson apply a visual representation of a customer's face to a check?

6). Stinson (including relied upon cols. 8, 9, 11, and 12) does not teach claims 10-11, 21-23, and 29-30, as alleged by the Office (at Action pages 5-6). Where does Stinson teach storing a customer image in correlated relation with a check image? Conversely, Stinson teaches that a customer "image [is] stored in conjunction with the customer's identification number" (col. 8, lines 22-25). Thus, Stinson teaches away from having a customer image stored in correlation with a check image.

7). Stinson (including relied upon cols. 5 and 7) does not teach claims 12-13, as alleged by the Office (at Action page 6). Claims 12 and 13 depend from claim 2, which features therein the Office has disregarded.

8). The Office has failed to document its evidence for rejection on the record, which is a mandatory requirement to allow appellate review of the basis for denial of a patent. Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a *prima facie* case of anticipation under the law. Appellants respectfully submit that the Office has not met its legally required burden.

Appellants reserve all rights to present additional arguments

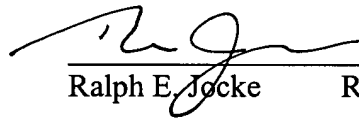
Because of the limited number of total pages allowed herein, the Appellants have not necessarily presented all their reasons as to why Stinson does not anticipate the claims.

Appellants reserve the right to later present additional reasons.

Conclusion

Appellants respectfully submit that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke

Reg. No. 31,029

WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000
Customer No. 28995